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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,670	01/09/2002	Charles F. Benninghoff III	BEN2.PAU.01	6171

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EXAMINER

TANG, KAREN C

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,670

Applicant(s)

BENNINGHOFF, CHARLES F.

Examiner

Karen C Tang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/15/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

I. Claims 1-4, 7-12, 14, 16-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitty et al hereinafter Mitty (US 6,199,052).

1. Referring to Claim 1, Mitty discloses a method for verifiably transmitting (delivery, refer to Col 1, Lines 10-20) an electronic package (refer to Col 1, Lines 10-20) from a sender (105, refer to Fig 1B) to a recipient (120, refer to Fig 1B) through a certifying authority (recipient which consists of a public key, refer to Col 4, Lines 35-67, and Col 5, Lines 1-25 and 115, refer to Col 14, Lines 65-67) via a public communications network (110, refer to Fig 1B), the method comprising the steps of:

receiving an electronic package (refer to Col 1, Lines 10-20) that is transmitted from the sender (refer to Col 1, Lines 10-40) to the certifying authority (recipient which consists of a public key, refer to Col 4, Lines 35-67, and Col 5, Lines 1-25 and 115, refer to Col 14, Lines 65-67) via the public communications network (110, refer to Fig 1B);

storing (archives, refer to Col 2, Lines 30-55) particulars relating to the electronic package (message, refer to Col 2, Lines 30-55) on a server (intermediary 115, refer to Col 9, Lines 50-67) operated by the certifying authority (recipient which consists of a public key, refer to Col 4, Lines 35-67, and Col 5, Lines 1-25 and 115, refer to Col 14, Lines 65-67) for use in later verifying the particulars relating to the electronic package (refer to Col 2, Lines 30-55);

delivering (delivery, refer to Col 1, Lines 10-20) the electronic package (refer to Col 1, Lines 10-20) from the certifying authority (recipient which consists of a public key, refer to Col 4, Lines 35-67, and Col 5, Lines 1-25 and 115, refer to Col 14, Lines 65-67) to the recipient via the public communications network (110, refer to Fig 1B);

generating an encrypted hash value (refer to Col 4, Lines 35-45) based on the particulars relating to the electronic package (messages, refer to Col 4, Lines 35-45) and the delivery thereof, the encrypted hash value uniquely identifying the particulars relating to the electronic package and the delivery thereof (Col 4, Lines 30-60);

and transmitting an electronic certificate (digital certificate, refer to Col 4, Lines 60-67) of service from the certifying authority (recipient which consists of a public key, refer to Col 4, Lines 35-67, and Col 5, Lines 1-25 and 115, refer to Col 14, Lines 65-67) via the public communications network (110, refer to Fig 1B), the electronic certifying of service

including the particulars relating to the electronic package (electronic document, refer to Col 4, Lines 60-67) and the encrypted hash value as verification of the content and delivery of the electronic package from the certifying authority to the recipient (refer to Col 4, Lines 30-67).

2. Referring to Claim 2, Mitty discloses the step of storing (archives, refer to Col 2, Lines 30-55) the electronic package (messages, refer to Col 4, Lines 35-45) on the server (intermediary, refer to Col 2, Lines 30-55) operated by the certifying authority (recipient which consists of a public key, refer to Col 4, Lines 35-67, and Col 5, Lines 1-25 and 115, refer to Col 14, Lines 65-67) for use in later producing a duplicate of the electronic package (message that has been recovered, refer to Col 4, Lines 35-67).

3. Referring to Claim 3, Mitty discloses wherein the electronic package (messages, refer to Col 4, Lines 35-45) comprises an email message (refer to Col 7, Lines 45-50).

4. Referring to Claim 4, Mitty discloses wherein the electronic package (messages, refer to Col 4, Lines 35-45) further comprises an email attachment (refer to Col 7, Lines 50-67 and Col 8, Lines 1-15).

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5. Referring to Claim 7, Mitty discloses wherein the particulars surrounding the electronic package (messages, refer to Col 4, Lines 35-45) comprises date and time of transmission (refer to Col 8, Lines 1-15).

6. Referring to Claim 8, Mitty discloses wherein the particulars surrounding the electronic package (messages, refer to Col 4, Lines 35-45) comprises identity of sender and identity of recipient (refer to Col 8, Lines 1-10).

7. Referring to Claim 9, Mitty discloses wherein the particulars surrounding the electronic package (messages, refer to Col 4, Lines 35-45) comprises an email address of sender and email address of recipient (refer to Col 8, Lines 1-10).

8. Referring to Claim 10, Mitty discloses wherein the particulars surrounding the electronic package (messages, refer to Col 4, Lines 35-45) comprises maximum number of days (predetermined time) within which to deliver the electronic package to the recipient (refer to Col 11, Lines 25-45).

9. Referring to Claim 11, Mitty discloses informing the sender, in event that delivery was not made to the recipient within the maximum number of days (predetermined time refer to Col 11, Lines 25-45).

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10. Referring to Claim 12, Mitty discloses wherein the particulars surrounding the electronic package (messages, refer to Col 4, Lines 35-45) comprises a date (predetermined time, refer to Col 15, Lines 1-20) through which the electronic package is to be stored (archived, refer to Col 14, Lines 65-67) by the certifying authority (recipient which consists of a public key, refer to Col 4, Lines 35-67, and Col 5, Lines 1-25 and 115, refer to Col 14, Lines 65-67).

11. Referring to Claim 14, Mitty discloses further comprising the steps of creating the electronic certificate of service as an encrypted file (refer to Col 9, Lines 10-67).

12. Referring to Claim 16, Mitty discloses the step of verifying an encrypted hash value that is questioned by transmitting the encrypted hash value to the certifying authority (recipient, refer to Col 4, Lines 30-67), and comparing the encrypted hash value that is questioned with records of the certifying authority (refer to Col 4, Lines 30-67 and Col 5, Lines 1-26).

13. Referring to Claim 17, Mitty discloses further comprising the step of notifying the recipient via the public communications network that the electronic package is available for pickup from the server operated by the certifying authority (refer to Col 2, Lines 40-55, Col 6, Lines 24-55 and Col 12, Lines 10-26).

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14. Referring to Claim 18, Mitty discloses wherein the step of delivering the electronic package from the certifying authority to the recipient via the public communications network (message transmit request, refer to Col 2, Lines 35-55) occurs upon a request for download (refer to Col 2, Lines 30-35) thereof by the recipient: and wherein the step of transmitting an electronic certificate (Digital Certificate, refer to Col 4, Lines 60-67) of service from the certifying authority via the public communications network (network, 110, refer to Fig 1A) takes place after completion of the delivering step (refer to Col 2, Lines 50-55 and Col 4, Lines 1-61).

15. Referring to Claim 19, Mitty discloses wherein the step of delivering the electronic package from the certifying authority (recipient which consists of a public key, refer to Col 4, Lines 35-67, and Col 5, Lines 1-25 and 115, refer to Col 14, Lines 65-67) to the recipient is legally presumed by virtue of sending the electronic package to a valid email address (refer to Col 10, Lines 1-45 and Col 6, Lines 1-15) associated with the recipient (recipient, 120, refer to Col 9, Lines 1-15).

16. Referring to Claim 20, Mitty discloses wherein the step of transmitting an electronic certificate of service transmits an electronic certifying of service to the sender (refer to Col 7, Lines 55-67).

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17. Referring to Claim 21, Mitty discloses wherein the step of transmitting an electronic certifying of service transmits an electronic certificate of service to the recipient (refer to Col 8, Lines 1-67 and Col 9-14).

18. Referring to Claim 22, Mitty discloses wherein the step of transmitting an electronic certificate of service transmits an electronic certificate of service (refer to Col 9, Lines 10-67) to a designee of the sender (trusted intermediary 115, refer to Col 9, Lines 65-67) other than the recipient (recipient, 120, refer to Col 9, Lines 1-15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

II. Claims 5, 6, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitty et al hereinafter Mitty (US 6,199,052) in view of Wong et al hereinafter Wong (US 6,654,746).

1. Referring to Claim 5, Mitty discloses wherein the electronic package ()

Mitty does not expressly indicate the electronic package consists an ascii file.

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Baker indicates the electronic package consists an ASCII files (email message, which consists a ASCII characters) (refer to Col 1, Lines 20-67)

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Mitty and Baker.

The suggestion/motivation for doing so would have been Mitty indicates usage of email and (refer to Col 6, Lines 1-15), and it is well known in the art that email software system can attach any kind of data files.

2. Referring to Claim 6, Mitty discloses the electronic package

Mitty does not expressly indicate the electronic package consists a binary file.

Baker indicate the electronic package (email) consists of a binary file (refer to Col 1, Lines 20-67).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Mitty and Baker.

The suggestion/motivation for doing so would have been Mitty indicates usage of email and (refer to Col 6, Lines 1-15), and it is well known in the art that email software system can attach any kind of data files.

3. Referring to Claim 13, Mitty discloses wherein tracked message (refer to Col 11, Lines 17-20) includes an email message and an email attachment and wherein the particulars surrounding the electronic package comprises identity of sender (refer to Col 15, Lines 40-55), email address of sender, identity of recipient (refer to Col 4, Lines 60-

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67), email address of recipient (relevant e-mail addresses, refer to Col 11, Lines 40-55), date of transmission, time of transmission (time stamp, refer to Col 11, Lines 40-55), length of the email message (message length, refer to Col 11, Lines 40-55), name of the email attachment (filename ,refer to Col 11, Lines 40-55), and size of the email attachment.

Mitty does not expressly indicate the size of the email attachment.

Wong indicate the size of email attachment (refer to Col 5, Lines 25-51)

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Mitty and Wong.

The suggestion/motivation for doing so would have been obvious for ordinary skill in the art to incorporate the idea because Mitty indicate the package could contains various information upon request (refer to Col 9, Lines 1-15).

III. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitty et al hereinafter Mitty (US 6,199,052) in view of "Official Notice"

1. Referring to Claim 15, Mitty indicate wherein the step of creating the electronic certificate of service as an encrypted file is accomplished by creating an encrypted file that is printable but not modifiable (refer to Col 4, Lines 30-67).

Mitty does not expressly indicate the use of PDF.

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"Official Notice" is taken that it is PDF is a common file format and is well known in the art that is it not modifiable for the viewers.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the "Official Notice" and Mitty.

The suggestion/motivation for doing so would have been that Mitty suggested the file is not been modified/alterd, thus, it is obvious for any ordinary skill in the art to modified the invention and indicate the type of file to be a PDF files, which is not modifiable.

Conclusion

A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571)272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KT


ZARNI MAUNG
SUPERVISORY PATENT EXAMINER